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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,930	07/17/2003	Susann Marie Keohane	AUS920030357US1	2228
48916	7590	11/23/2010		
Greg Goshorn, P.C. 9600 Escarpment Suite 745-9 AUSTIN, TX 78749				
EXAMINER				
HUSSAIN, TAUQIR				
ART UNIT		PAPER NUMBER		
2452				
MAIL DATE		DELIVERY MODE		
11/23/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/621,930

**Applicant(s)**

KEOHANE ET AL.

**Examiner**

TAUQIR HUSSAIN

**Art Unit**

2452

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3, 10 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 10 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to amendment/reconsideration filed on 08/26/2010, the amendment/reconsideration has been considered. Claim 10, have been amended. Claims 3, 10 and 17 are pending for examination, the rejection cited as stated below.

### ***Response to Arguments***

2. Applicant's arguments, with respect to the rejection(s) of independent claims 3, 10 and 17 under U.S.C 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made cited as below.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oizumi et al (Patent No.: US 7,302,470 B2), hereinafter "Oizumi" in view of Gropper et al (Patent No.: US 7,505,974 B2), hereinafter "Gropper".

5. As to claim 3, Oizumi discloses a method for alerting e-mail users (Oizumi, Abstract) comprising:

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if a failed delivery e-mail message is received, setting an indicator in an entry in one of an address book, an address database, and an address cache associated with an address of an addressee corresponding to the failed delivery message (Oizumi, Col.2, lines 40-47, where failed delivery status is indicated as false value and the result is associated with searchable address database);

displaying said address in conjunction with a perceptive cue in response to said indicator being set (Oizumi, Col.2, lines 54-59, address is stored in conjunction with a perceptive cue in response to set indicator set as false-indicating value and is displayable upon search);

wherein, if said indicator is set, said indicator is operable for clearing in response to said address becoming accessible (Oizumi, Col.2, lines 50-53, if it is found in the e-mail address database that the sending failed, then it is further determined whether the domain name of the destination e-mail address is found in the e-mail address database. When such a domain name is found / become accessible, the e-mail is sent to the input e-mail address).

Oizumi however is silent on disclosing explicitly, clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message.

Gropper however discloses a similar concept as, clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message (Gropper, Col.2, lines 41-52, in essence to an updated request of an address, see figure.3B, element-386, set indicators gets reset according to the user responses via email).

Therefore, it would have been obvious to one of the ordinary skilled in the art at the time the invention was made to combine the teachings of "Oizumi" with the teachings of "Gropper" in order to provide users of digital address books, wireless telephones, Personal Information Managers, and other digital applications and devices ("digital address books") with a more efficient, more cost effective, more accurate, and less manually intensive method for entering and updating information stored in the device. Addressees of update requests need not have previously registered with the system, see summary Col.1, lines 63-67 and Col.2, lines 1-2).

6. As to claim 10, Oizumi discloses, a computer program product embodied in a tangible non-transitory storage medium (Oizumi, Abstract), the program product for alerting e-mail users comprising programming instructions for:

if a failed delivery e-mail message is received, setting an indicator in an entry in one of an address book, an address database, and an address cache associated with an address of an addressee corresponding to the failed delivery message (Oizumi, Col.2, lines 40-47, where failed delivery status is indicated as false value and the result is associated with searchable address database);

displaying said address in conjunction with a perceptive cue in response to said indicator being set (Oizumi, Col.2, lines 54-59, address is stored in conjunction with a perceptive cue in response to set indicator set as false-indicating value and is displayable upon search);

wherein, if said indicator is set, said indicator is operable for clearing in response to said address becoming accessible (Oizumi, Col.2, lines 50-53, if it is found in the e-mail address database that the sending failed, then it is further determined whether the domain name of the destination e-mail address is found in the e-mail address database. When such a domain name is found / become accessible, the e-mail is sent to the input e-mail address).

Oizumi however is silent on disclosing explicitly, programming instructions for clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message.

Gropper however discloses a similar concept as, programming instructions for clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message (Gropper, Col.2, lines 41-52, in essence to an updated request of an address, see figure.3B, element-386, set indicators gets reset according to the user responses via email).

Therefore, it would have been obvious to one of the ordinary skilled in the art at the time the invention was made to combine the teachings of "Oizumi" with the teachings of "Gropper" in order to provide users of digital address books, wireless telephones, Personal Information Managers, and other digital applications and devices ("digital address books") with a more efficient, more cost effective, more accurate, and less manually intensive method for entering and updating information stored in the device. Addressees of update requests

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need not have previously registered with the system, see summary Col.1, lines 63-67 and Col.2, lines 1-2).

7. As to claim 17, Oizumi discloses, a data processing system (Oizumi, Abstract) comprising:

circuitry operable for, if a failed delivery message is received, setting an indicator in an entry in one of an address book, an address database, and an address cache associated with an address of an addressee corresponding to the failed delivery message (Oizumi, Col.2, lines 40-47, where failed delivery status is indicated as false value and the result is associated with searchable address database);

circuitry operable for displaying said address in conjunction with a perceptive cue in response to said indicator being set (Oizumi, Col.2, lines 54-59, address is stored in conjunction with a perceptive cue in response to set indicator set as false-indicating value and is displayable upon search);

wherein, if said indicator is set, said indicator is operable for clearing in response to said address becoming accessible (Oizumi, Col.2, lines 50-53, if it is found in the e-mail address database that the sending failed, then it is further determined whether the domain name of the destination e-mail address is found in the e-mail address database. When such a domain name is found / become accessible, the e-mail is sent to the input e-mail address).

Oizumi however is silent on disclosing explicitly, circuitry operable for clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message.

Gropper however discloses a similar concept as, circuitry operable for clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message (Gropper, Col.2, lines 41-52, in essence to an updated request of an address, see figure.3B, element-386, set indicators gets reset according to the user responses via email).

Therefore, it would have been obvious to one of the ordinary skilled in the art at the time the invention was made to combine the teachings of "Oizumi" with the teachings of "Gropper" in order to provide users of digital address books, wireless telephones, Personal Information Managers, and other digital applications and devices ("digital address books") with a more efficient, more cost effective, more accurate, and less manually intensive method for entering and updating information stored in the device. Addressees of update requests need not have previously registered with the system, see summary Col.1, lines 63-67 and Col.2, lines 1-2).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Karamchedu et al. (US 20080065891 A1, Fig.1, abstract).
- Houde et al (579094, Abstract).



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- Eggleston et al. (5958006, Col.7, lines 31-56)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAUQIR HUSSAIN whose telephone number is (571)270-1247. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu V. Nguyen can be reached on (571) 272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TAUQIR HUSSAIN/  
Examiner, Art Unit 2452

